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| 10/776,851 | 02/11/2004 | Uwe Jurgen Becker | CM2687MQ | 3886 |

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| EXAMINER |
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BOGART, MICHAEL G

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| ART UNIT | PAPER NUMBER |
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01/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/776,851 | BECKER ET AL. | |
| | Examiner | Art Unit | |
| | Michael G. Bogart | 3761 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9,12 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9,12 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/31/07 & 1/4/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 31 October 2007 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 11/717,234. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '234 application claims every material limitation of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7 and 16 of copending Application No. 11/717,235. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '235 application claims every material limitation of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 11/717,556.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the '556 application claims every material limitation of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

4. Claims 1, 3-7 and 12 are rejected under 35 U.S.C. § 103(a) as obvious over Tanzer *et al.* (WO 01/15647 A1) hereinafter "Tanzer").

Regarding claim 1, Tanzer teaches a disposable diaper (10) comprising:

A chassis including a liquid impervious backsheet (12) and a liquid pervious topsheet (14); and

An absorbent core (42, 58) located between said backsheet (12) and said topsheet (14) which includes first and second substrate layers (42) each having absorbent material (58) deposited thereon and a thermoplastic material (the hot melt adhesive that is sprayed on the various webs), which contacts at least portions of the absorbent material (58) and at least portions of the substrate layer (42) such that the absorbent material is immobilized on said substrate layer, said absorbent material (58) comprising an absorbent polymer material and a absorbent fibrous material, said absorbent fibrous material representing less than about 20 % of the weight of absorbent polymer material, wherein said absorbent material (58) is immobilized (trapped in pockets (50)) when wet such that said absorbent core (42, 50, 58) achieves a wet immobilization (liquid is immobilized in the pockets (50) by the superabsorbent (58))(page 6, line 8-page 8, line 2; page 10, line 3-page 11, line 19)(see fig. 2, *infra*)(see e.g., Babu *et al.* (US 5,401,792)) which teaches that hot melt adhesives are thermoplastic at col. 1, lines 14-23).

It is noted that Tanzer teaches superabsorbent polymers and that superabsorbent can be combined with fibrous where the amount of superabsorbent material by weight is at least 90%, meaning the amount of fibrous material is no more than 10% (see page 7).

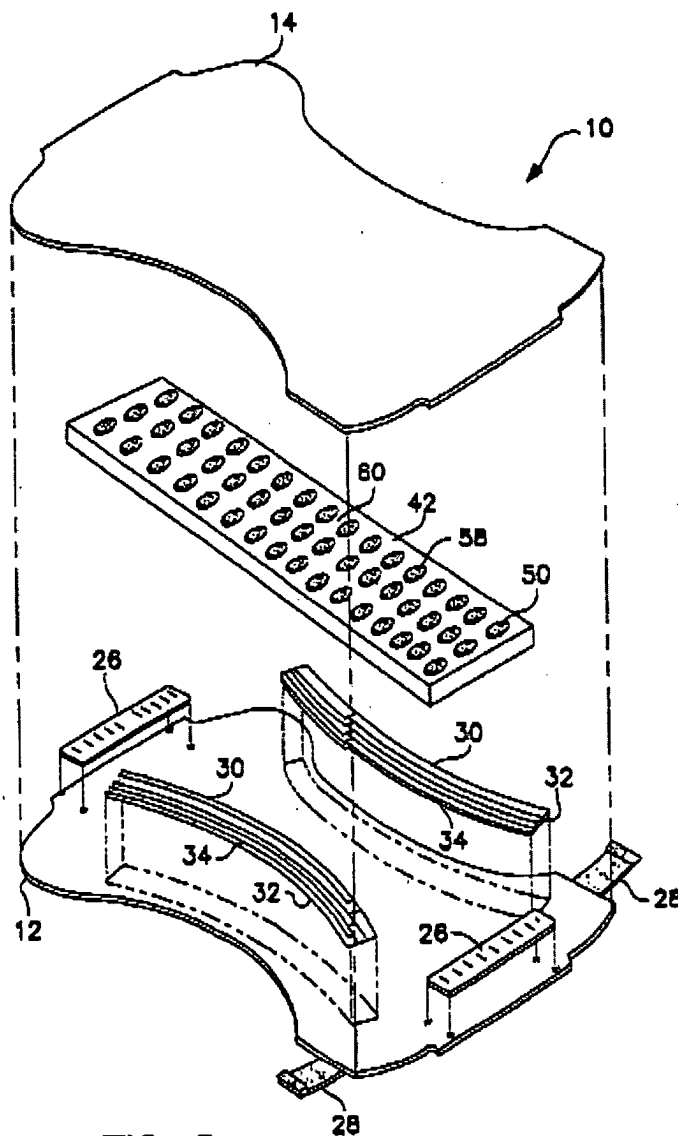


FIG. 2

Regarding the second substrate layer, see page 6, lines 8-11.

Tanzer does not expressly disclose the specific degree of wet immobilization.

Generally, optimization of ranges of performance test vectors will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such test characteristic is critical. "[W]here the general conditions of a claim are disclosed in the

prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Regarding claims 1 and 13, the benefits of immobilizing the inner materials of a diaper when soaked with urine would have been known prior to applying a test (e.g., preventing the absorbent materials from bunching up excessively in discrete areas of the diaper causing discomfort to a wearer, or aesthetic considerations), making these values result-effective variables. One of ordinary skill in the art would have recognized that increasing the wet immobilization properties of the absorbent material in a diaper or similar article would increase its resistance to moving around between top and back sheets and would prevent the absorbent from bunching up uncomfortably. MPEP § 2144.04.

Regarding claims 3 and 21, Tanzer teaches that the thermoplastic material includes a hot melt or auxiliary adhesive (page 11, lines 12-19).

Regarding claim 4, Tanzer teaches that said thermoplastic material (12, 42) is fiberized or fibrous (page 9, line 3-page 10, line 10, line 2).

Regarding claims 5, Tanzer teaches that said thermoplastic material (12, 42) substantially immobilizes said absorbent polymers (58)(page 11, lines 12-19).

Regarding claim 6, Tanzer teaches the absorbent core (12, 42, 50, 58) having a distribution of absorbent polymer material wherein the distribution of absorbent polymer

material is profiled (polymer (58) distribution changes along longitudinal length of sheet (12))(see fig. 3, supra).

Regarding claim 7 and 12, mere changes in size alone are not sufficient to patentably distinguish an invention over the prior art. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

5. Claims 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanzer as applied to claim 1 above, and further in view of Sauer (US 5,527,300 A).

Tanzer does not expressly teach a hydrophilic nonwoven substrate.

Sauer teaches a hydrophilic nonwoven surge management layer (46) disposed over an absorbent core (col. 23, lines 31-38).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to substitute or augment the surge management layer of Tanzer with the surge management layer of Sauer in order to provide a layer that is known in the art to be suitable for managing liquid surges.

Furthermore where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007)(citing *KSR v.*

Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent persuasive evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007)(citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Response to Arguments

Applicant's arguments filed 31 October 2007 have been fully considered but they are not persuasive.

Applicants assert that Tanzer does not teach a thermoplastic material that contacts at least portion of the absorbent material and at least portions of the substrate layer in order to immobilize the absorbent material on the substrate material. This argument is not persuasive because Tanzer teaches that the pocketed layer, after being filled with the superabsorbent is sprayed with a hot melt adhesive that is used to secure it to the other webs of the article. Such

spraying would contact both the pocketed layer and the superabsorbent contained therein. As shown by Babu *et al.*, hot melt adhesive is thermoplastic. Once the pocketed layer has been secured to the other layers, the superabsorbent in the pockets is immobilized due to the adhesive securing of the layers (see Tanzer, page 11, lines 12-19).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

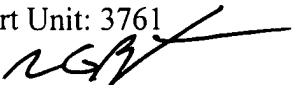
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number:

10/776,851

Art Unit: 3761



Michael Bogart

16 July 2007

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TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

